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EXAMINER

HUGHES, ALICIA R

ART UNIT	PAPER NUMBER
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1614

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Status of the Claims

Claims 1-28, 36-43, and 45-56 are pending and the subject of this Office Action. Claims 29-35 and 44 are withdrawn further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections – 35 U.S.C. §103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-28, 36-43, and 45-56 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,342,527 B1 [hereinafter referred to as O'Lenick et al."'] in view of U.S. Patent No. 6,491,927 B1 [hereinafter referred to as "Arnaud et al."'].]

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As noted in this Office's previous action of 14 February 2007, O'Lenick et al. teach a polyester and a process for providing gloss to the skin that comprises the application of an effective glossing concentration of the polyester. The compounds disclosed therein "are formulated into lipsticks and color cosmetics" (Col. 5, lines 25-27). More specifically, O'Lenick et al. teaches the esterification of castor oil with a fatty acid to produce an intermediate that possesses both an ester and a triglyceride function (Col. 1, lines 43-45), and further that "[t]he unique structure of castor oil coupled with the proper selection of the fatty acid and diacid chosen to make the polyester results in a product that has unique gloss when applied to the skin" (Col. 1, lines 53-55). The invention also teaches the predominant species in castor is ricinoleic acid, which has the following structural formula:



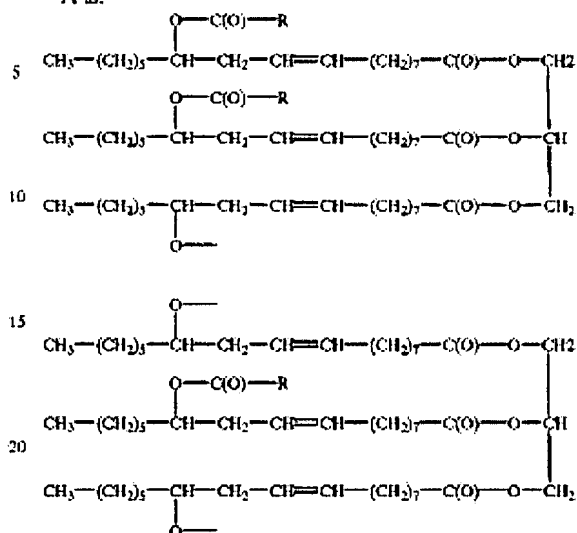
and "[i]t is this ricinoleic moiety that when linked to a guerbet alcohol in an ester gives unique gloss when applied to the skin" (Col. 3, lines 23-28 and 39-41).

The polyester taught by O'Lenick et al conforms to the following structure:



wherein

A is:



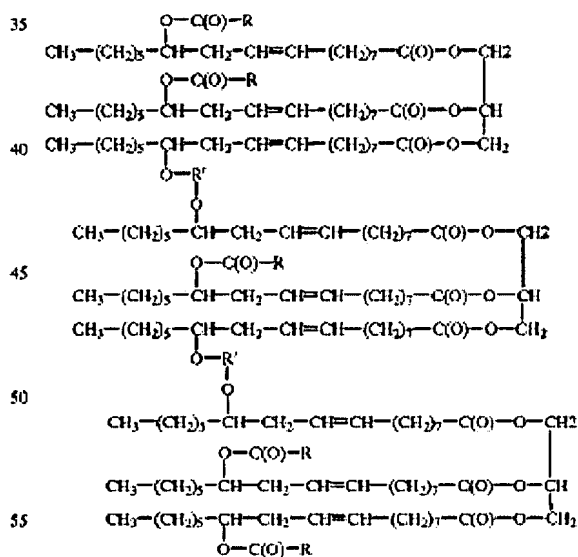
25 wherein;

the linking group between all of the O— are succinyl groups conforming to the following structure
 $\text{—C(O)—CH}_2\text{CH}_2\text{—C(O)—}$;

30 R is selected from alkyl and alkylene having 5 to 33 carbon atoms;

x is an integer ranging from 1 to 50.

In a simple case where x is 1 the following polymer results:



The polyester disclosed in O'Lenick et al. is made by esterification of the following raw materials: (1) the triglyceride, castor oil, more specifically; (2) aliphatic monocarboxylic acids,

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chosen from the list of fatty acids containing from 6 to 34 carbon atoms; and (3) an aliphatic dicarboxylic acid, more particularly, succinic acid, which conforms to the following structural formula:



(Cols. 3, line 18 and lines 55-66, col. 4, lines 1-66).

O'Lenick et al also teach that by "selecting ratios of reactants, the castor oil can be partially substituted with fatty acid leaving some unreacted hydroxyl groups. The number of remaining hydroxyl groups, and the type and concentration of diacid used to react with the unreacted hydroxyl groups, results in a controllable polyester" (Col. 1, lines 45-51).

Although O'Lenick et al. teach the polyester that is the subject of the instant invention, O'Lenick et al do not teach the polyester in a composition with an oil with a high molecular weight, or a molar mass ranging from 650 g/mol to 10000 g/mol, or the concentrations of polyester and the other oil that comprise the composition. The same, however, are taught in Arnaud, et al., among other limitations advanced as part of the present invention.

Arnaud et al teach a cosmetic composition comprising a saturated and branched C₂₄ to C₂₈ fatty alcohol or fatty acid ester in the form of oil at room temperature and of high molecular weight (See Abstract, p. 1) and at least one additional oil that is not the triglyceride, but holds a high molecular weight (Col. 10, lines 45-54 and col. 10, lines 36-38). Arnaud et al teach that amongst the oils of choice is hydrogenated polyisobutene (Col. 5, line 8) and that the oil can represent from 0 % to 99.9% by weight of the composition (Col. 5, lines 28-30) and likewise, the polyester can represent from 0.1% to 99.9% (Col. 10, lines 45-53 and Col. 14, lines 21-23). Arnaud et al also teach that the composition can contain colorants (Col. 3, lines 62-67 and Col. 4,

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lines 1-3) and waxes, polyethylene waxes, for example (Col. 4, line 53), which “[a]fter homogenizing and milling the pigments, the mixture is cast into appropriate moulds” (Col. 6, lines 64-65).

Finally, Arnaud et al also teach a method for preparing a cosmetic composition that contains at least one polyester, at least one other oil or wax, and a colorant, which is non-sticky, non-greasy, and/or glossy when applied to the skin (Col. 11, lines 39-42, claim 17) and a method for conferring on the same “an emollient and/or film-forming and/or cohesive and adhesive nature when composition is in pulverulent form” (Col. 11, lines 53-64, claim 19).

One of ordinary skill in the art would be motivated to combine the teachings of O’Lenick et al with the teachings of Arnaud et al, due to the overlapping subject matter contained in each, most notably, cosmetic compositions containing polyesters resultant from esterification that can be lipstick as a finished product, for example.

Applicant argues that a *prima facie* case of obviousness has not been established, because the above teachings lack a suggestion or motivation to combine the teachings of O’Lenick with the teachings of Arnaud. As a matter of law, however, a *specific* teaching, suggestion, or motivation is not required to establish a *prima facie* case of obviousness. *See Ex parte Smith*, -- USPQ 2d --, slip opinion at 20 (Board of Patent Appeals and Interferences, 25 June 2007), *citing KSR v. Teleflex*, 82 USPQ2d 1385 (2007) at page 1396.

More specifically, The Supreme Court has held that while the “teaching, suggestion, motivation” approach is a valid form of analysis under *Graham v. Deere*, it is not the only one. *See KSR v. Teleflex*, at page 1397 where Justice Kennedy, speaking for a unanimous court, states:

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The same constricted analysis led the Court of Appeals to conclude, in error, that a patent claim cannot be proved obvious merely by showing that the combination of elements was "obvious to try."... When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

The Court of Appeals, finally, drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias. A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See *Graham*, 383 U.S., at 36 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 [141 USPQ 549] (CA6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.

In consideration of the foregoing, it would have been *prima facie* obvious to one of ordinary skill in the art to combined an esterfied triglyceride which results in a polyester with another high molecular weight oil and colorant to create the presently claimed invention.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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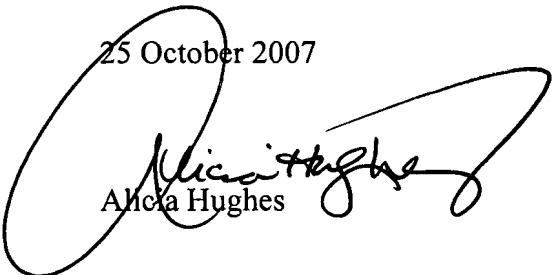
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Hughes whose telephone number is 571-272-6026. The examiner can normally be reached from 9:00 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Public PAIR only. For information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

25 October 2007


Alicia Hughes


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER